

Remarks/Arguments

Claims 1 and 3 are amended, Claim 2 is canceled without prejudice and Claims 4 – 15 are added. It follows then that Claims 1 and 3-13 are currently pending. Reconsideration of amended Claims 1 and 3 and examination of new Claims 4-15 is respectfully requested.

Rejection Under 35 U.S.C. §112

The Examiner states that Claims 1-3 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleges that the phrase “having a desired exo mole percent” renders the claim vague and indefinite as a “desired” amount can be from 0 to infinity. The Examiner further states that she is “unclear as to what the applicant is claiming as his invention.” Applicant does not agree that such terminology is vague and indefinite when considered in light of the teachings of the specification.

Notwithstanding Applicant’s disagreement, and solely for the purpose of expediting the prosecution of the instant application, Applicant has amended Claims 1 and 3 and canceled Claim 2 without prejudice. The rejection of such canceled claim is thus moot.

With regard to amended Claim 1, such claim now includes a recitation extracted from the specification to define within the claim itself, rather than requiring reference to the specification, a definition of “a desired exo mole percent.” Specifically such recitation is found in paragraph [0042] of the instant application as filed. Amended Claim 3 now depends from Claim 1 and hence also incorporates such definition.

Therefore Applicant believes that the Examiner's rejection of Claims 1 and 3, as amended, has been overcome and respectfully requests that such rejection be withdrawn.

With regard to new Claims 4 -15, Applicant believes that such claims are not indefinite or vague and hence no rejection under §112 is appropriate.

If, however, the Examiner believes the currently pending claims are vague and/or indefinite, Applicant respectfully requests the Examiner suggest alternate language in accordance with MPEP §2173.02, which states:

However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

Rejection Under 35 U.S.C. §101

The Examiner states that Claims 2-3 are rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101. Applicant disagrees and respectfully asserts that each of original Claims 2 and 3 set forth a positive step and hence the Examiner's rejection under §101 is incorrect.

Notwithstanding Applicant's disagreement, Claim 2 has been canceled and Claim 3 amended to not recite a method, thus the rejection of such claims under §101 is moot and must, for at least that reason, be withdrawn.

Rejections Under 35 U.S.C. §102(b) and (e)

The Examiner states that Claims 1-3 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Kinsho et al (US 6,284,429 B1). Further The Examiner states that Claims 1-3 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Shin et al (US 2003/0004289 A1). Still further, the Examiner states that Claims 1-3 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Boardman et al (US 6,358,675 B1). Applicant respectfully traverses each of these three rejections.

The embodiments of the instant invention are all related to the Applicant's discovery that the exo mole percent of a polycyclic olefin derived repeat unit incorporated into a polycyclic olefin derived resin unexpectedly affected the dissolution rate of such polymer. Thus by selecting a desired exo mole percent for the monomer used to form repeat units Applicant discovered, and through experimentation obtained an understanding thereof, that allowed for the submitting of the instant application which claims and discloses what are believed to be inventive embodiments that incorporate Applicant's discovery by and through the understanding thereof obtained through the aforementioned experimentation.

Collectively, none of Kinsho et al., Shin et al. or Boardman et al. recognize, teach or even suggest that there is any relationship between the isomeric ratio of a polycyclic olefin monomer and the dissolution rate of a polymer that incorporates such a monomer as a repeating unit thereof. Absent such a teaching, disclosure or suggestion, none of such references can anticipate either the original Claims 1-3 or any of the current pending Claims 1 and 3-15. Thus it must follow that each of the rejections under §102 must be withdrawn.

In summary, Applicant has provided Amended Claims 1 and 3 and New Claims 4 – 15 for the Examiners consideration. Applicant has

remarked and stated that the amendments made to Claims 1 and 3 where not made for reasons of patentability as it is believed that the original rejections under §112 and §101 were incorrect. Further, Applicant having reviewed the art cited under the §102 rejections has directed the Examiner to the fact that none of such references even recognized a relationship between the isomer ratio of polycyclic olefin derived repeat units and dissolution rates of a resin or photoresist composition made therewith. Thus, failing to recognize what Applicant has discovered and come to understand, as disclosed in the instant application, it is impossible for such references to anticipate the embodiments in accordance with the present invention claimed in pending Claims 1 and 3-15.

Therefore Applicant respectfully requests that after consideration of the amendments and remarks herein, the Examiner pass the instant application to issuance. Such action is earnestly sought. If however the Examiner disagrees, Applicant requests that the Examiner call the undersigned to schedule a telephonic or personal interview in the hope that such action will expedite completing this prosecution.

Respectfully submitted,

By 
Bernard Berman, Reg. No. 37,279

c/o Promerus, LLC
9921 Brecksville Rd
Brecksville, Ohio 44141
(440) 922-1469
bernie.berman@promerus.com